



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/797,047

03/11/2004

Takao Tsubouchi

2004-0393A

4686

513 7590 07/27/2007
WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

ROSS, DANA

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,047

Applicant(s)

TSUBOUCHI, TAKAO

Examiner

Dana Ross

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-51 is/are allowed.
- 6) ☒ Claim(s) 29-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/10/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 29-36, 39-44, 47 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,098,127 (Williamson et al.).

Williamson et al. disclose a magazine comprising at least two generalized substantially sized pages (14a and 14b, for example) permanently bound together (see figure 4, for example) and printable sheets of at least one specialized pages (34), the specialized pages being attached to the magazine (12), an adhesive side (26) with an adhesive layer and the printable sheets being inherently printed by a conventional printing means since the sheets receive advertising indicia.

Williamson et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (e.g., the generalized and specialized page, and the printable side containing content of a general and specific nature with respect handbook) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may

Art Unit: 3722

render the device more convenient by providing an individual with a specific type of page does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

Regarding claim 31, the handbook functioning as at least one of an official record and an indication of qualification sets forth the intended use of the handbook. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding 32, the printable sheet comprises multiple printing spaces (wherein the printing spaces would be located anywhere on the printable sheets) forming corresponding multiple pages of the specialized pages and the adhesive layer (26) being formed on at least a portion of the back of one of the printing spaces (see column 3, lines 59-62).

Regarding claims 33, 35, 39, 41, 43 and 47, Williamson et al. disclose the size of the printing space being smaller than that of the generalized pages (as seen in figure 1). In the event that Applicant does not agree that Williamson expressly discloses the printing space smaller than a size of each of the generalized pages, Applicant is referred to the below 35 USC 103 obvious rejection.

Art Unit: 3722

Regarding claims 34, 36, 40, 42 and 44, Williamson et al. further disclose at least one fold line (22) disposed along a border between at least two of the printing spaces by which the printable sheet can be folded up into a concertina (see figures 1 and 3) and the adhesive layer being formed on at least a portion of the back of the printing spaces (see column 3, lines 59-62).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33, 35, 39, 41, 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al.

Williamson et al. discloses the claimed invention except for explicitly disclosing the size of the printing space and the generalized page. It would have been an obvious matter of design choice to provide any desired dimensions for the printing space and generalized page, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, applicant has failed to disclose that the size of the printing space is critical to the invention.

Art Unit: 3722

5. Claim 37-38 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson in view of US Pat. No. 5,826,914 (Hudetz).

Williamson et al. disclose the claimed invention except for the at least one printing space being separable from the printable sheet by at least one perforated line.

Hudetz discloses a magazine having a printable insert (10) having perforations (20) for separating a portion (18) of the insert from the remainder of the insert. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the printable sheet in the magazine of Williamson to include perforations and a removable section, as taught by Hudetz, to enable the removable portion to be separately used (e.g., postal reply card).

Allowable Subject Matter

6. Claims 48-51 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art neither anticipates nor renders obvious a handbook as claimed in new independent claim 48. The closest prior art is as discussed above. Neither Williamson nor Hudetz, either alone or in combination, disclose the combination of limitations, specifically wherein the combination includes a detachable sheet removably attached to a surface of the adhesive side so as to cover at least a portion of the adhesive layer. Furthermore, there is no motivation found to modify the prior art to obtain the claimed invention. Additionally, to modify the prior art to obtain the claimed invention would require hindsight.

Applicant's arguments were persuasive and the new claim limitations overcome the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

7. Applicant's arguments with respect to claims 29-47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

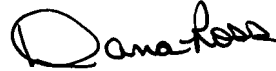
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dana Ross
Primary Examiner
Art Unit 3722


dmr